

REMARKS

In the Office Action, the Examiner rejected claims 1-51. By this Response, Applicant amended claims 1 and 46 for clarification and to expedite allowance of the present application. No new matter has been added by the foregoing amendments. Upon entry of these amendments, claims 1-51 will be pending in the present application and are believed to be in condition for allowance. Accordingly, the Applicants respectfully request reconsideration of the present application in light of the following remarks.

Rejections Under 35 U.S.C. § 102

Claims 1-18, 20-48, 50, and 51 were rejected under 35 U.S.C. § 102(b) as being anticipated by Goodrich et al. (U.S. Patent No. 5,375,076). Although the Applicant has amended claim 1 to clarify the recited subject matter, Applicant respectfully traverses the rejection of independent claims 1, 21, 37, and 46 and their respective dependent claims.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Independent Claim 1:

Regarding independent claim 1, as amended above, the Applicant respectfully stresses the recitation of "a *vertical mount* structure configured to mount the housing on a substantially *vertical surface*." (Emphasis Added). Applicant also respectfully traverses the Examiner's argument that claim 1 recites a functional limitation under 35 U.S.C. § 112, sixth paragraph. Instead, Applicant intended a broad interpretation of claim 1 in

terms of "configured to" language. As amended, claim 1 recites a "vertical mount structure," whereas the Goodrich et al. reference teaches nothing more than a horizontal mount for a horizontal surface. See Figures 4, 9, and 17. More specifically, the Goodrich et al. reference discloses a pivotable stand 36 mountable to a central portion of the housing 20, such that the housing can be supported at a *non-vertical angle* relative to a *horizontal surface*. See Col. 3, line 67 – col. 4, line 11. As disclosed by Goodrich et al., the central attachment of the pivotable stand 36 precludes an upright or vertical support of the housing 20, because the stand 36 cannot provide sufficient lateral support and stability for the weight above the central portion of the housing 20. See Figures 4, 9, and 17. The Goodrich et al. reference is absolutely devoid of a mount capable of vertically mounting the housing 20, whether the surface is horizontal or vertical.

In fact, the computer P1 would not function as intended if a vertical mounting were attempted. Applicant reminds the Examiner that a proposed modification cannot render the prior art reference unsatisfactory for its intended purpose, nor can the modification change the principle of operation of the prior art reference. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). The Examiner also appears to be asserting that Goodrich et al. inherently disclose a vertical mount structure or capability, as recited in claim 1. Applicant respectfully stresses that inherency cannot be established by probabilities, possibilities or the mere fact that a certain thing may result from a given set of circumstances. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). To anticipate under a theory of inherency, the Examiner must provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not provided cogent reasoning or evidence to support his apparent inherency position regarding a vertical mount structure, as recited in claim 1.

Accordingly, the Goodrich et al. reference fails to anticipate amended claim 1 and its respective dependent claims.

Independent Claim 21:

Regarding claim 21, the Goodrich et al. reference fails to disclose all recited features of the claim. For instance, one of the recited features of claim 21 not disclosed or suggested by the Goodrich et al. reference is "a mounting assembly for the housing configured to facilitate a *desired upright orientation* of the display and a *shallow horizontal space consumption* of the housing." (Emphasis Added). As illustrated in Figures 4, 9, and 17, the stand 36 can only pivot relative to the main housing 20 such that the housing 20 and stand 36 utilize a *deep* horizontal space in a *non-upright* orientation. Again, the Examiner appears to be asserting an unsupported modification or an inherent disclosure of the Goodrich et al. reference to provide the upright and shallow mount features recited in claim 21. First, the computer P1 would not function as intended if an upright mounting were attempted. *See In re Gordon*, 733 F.2d 900; *see also In re Ratti*, 270 F.2d 810. Second, Examiner has not provided cogent reasoning or evidence to support his apparent inherency position regarding a "desired upright orientation" and "shallow horizontal space consumption," as recited in claim 21. *See In re Robertson*, 169 F.3d 743; *see also Ex parte Levy*, 17 U.S.P.Q.2d 1461. The Goodrich et al. reference is simply devoid of any teaching or suggestion of a mounting assembly configured for such an upright orientation and shallow horizontal space consumption, as recited in claim 21. Accordingly, the Goodrich et al. reference fails to anticipate amended claim 21 and its respective dependent claims.

Independent Claim 37:

Regarding claim 37, the Goodrich et al. reference fails to disclose all recited features of the claim. For instance, one the recited features of claim 37 not shown by the

Goodrich et al. reference is "a support assembly configured to facilitate a *substantially vertical orientation* of the display screen and a *slim horizontal depth consumption* by the computer enclosure." (Emphasis Added). As illustrated in Figures 4, 9, and 17, the stand 36 can only pivot relative to the main housing 20 such that the housing 20 and stand 36 utilizes a *large horizontal depth in a non-vertical orientation*. Again, the Examiner appears to be asserting an unsupported modification or an inherent disclosure of the Goodrich et al. reference to provide the vertical and slim mount features recited in claim 37. First, the computer P1 would not function as intended if a vertical mounting were attempted. See *In re Gordon*, 733 F.2d 900; see also *In re Ratti*, 270 F.2d 810. Second, Examiner has not provided cogent reasoning or evidence to support his apparent inherency position regarding a "substantially vertical orientation" and a "slim horizontal depth consumption," as recited in claim 37. See *In re Robertson*, 169 F.3d 743; see also *Ex parte Levy*, 17 U.S.P.Q.2d 1461. The Goodrich et al. reference is simply devoid of any teaching or suggestion of a support assembly configured for such a substantially vertical orientation and slim horizontal depth consumption, as recited in claim 37. Accordingly, the Goodrich et al. reference fails to anticipate amended claim 37 and its respective dependent claims.

Independent Claim 46:

Regarding claim 46, the Goodrich et al. reference fails to disclose all recited features of the claim. For instance, one of the recited features of amended claim 46 not shown by the Goodrich et al. reference is "facilitating a *shallow horizontal depth consumption* of the thin panel enclosure via the *vertical support assembly*." (Emphasis Added). In this rejection of claim 46, the Examiner asserted the method steps are necessitated by the device structure as disclosed by Goodrich et al. Applicant respectfully traverses this rejection. As discussed above, the Goodrich et al. reference does not disclose "a shallow horizontal depth consumption," as recited in the amended claim 46. Also, as shown in Figs. 4, 9, and 17, the horizontal space utilized by the unit is

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from the edge of the main housing 20 to the edge of the stand 36, which is not a *shallow horizontal depth*. Again, the Examiner appears to be asserting an unsupported modification or an inherent disclosure of the Goodrich et al. reference to provide the features recited in claim 37. First, the computer P1 would not function as intended if a "shallow horizontal depth consumption" were attempted with the stand 36. *See In re Gordon*, 733 F.2d 900; *see also In re Ratti*, 270 F.2d 810. Second, Examiner has not provided cogent reasoning or evidence to support his apparent inherency position regarding a "shallow horizontal depth consumption" and a "vertical support assembly," as recited in claim 46. *See In re Robertson*, 169 F.3d 743; *see also Ex parte Levy*, 17 U.S.P.Q.2d 1461. Accordingly, the Goodrich et al. reference fails to anticipate amended claim 46 and its respective dependent claims.

In view of the foregoing remarks, independent claims 1, 21, 37, and 46 and their respective dependent claims are believed to be patentable over the Goodrich et al. reference. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. § 103

Claims 19 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodrich et al. (U.S. Patent No. 5,375,076) in view of Jacklin (U.S. Pat. No. 6,396,472). Applicant respectfully traverses the rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). If the Examiner combines the teachings of the prior art to produce the claimed invention, a *prima facie* case of obviousness cannot be established absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the

Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Claims 19 and 49 are believed to be patentable by way of their dependencies on independent claims 1 and 46 and by way of further distinguishing features recited in each respective claim. As discussed above, independent claims 1 and 46 are believed to be patentable over the Goodrich et al. reference, and the Jacklin reference provides no disclosure or teaching that would obviate the deficiencies of the Goodrich et al. reference.

Additionally, Applicant stresses the impropriety of the Examiner's proposed combination of the cited references. First, the Jacklin reference is non-analogous art to the claimed invention and the Goodrich et al. reference. Second, even if the Jacklin reference is considered as analogous art, the teachings are insufficient for the Examiner to make out a *prima facie* case of obviousness. For example, the Examiner has not provided evidence of any suggestion or motivation to combine the references.

In regard to the first point, for the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 U.S.P.Q. 969, 971 (C.C.P.A. 1979). Non-analogous art cannot properly be pertinent prior art under 35 U.S.C. § 103. *In re*

Pagliaro, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981). The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (Fed. Cir. 1984). In *Union Carbide*, the court found that the first determination was whether "the reference is within the field of the inventor's endeavor." If it is not, one must proceed to the second step "to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In regard to the second step, *Bott v. Fourstar Corp.*, 218 U.S.P.Q. 358 (E.D. Mich. 1983) determined that "analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention." "To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist." *Id.*

Based on the foregoing two-part non-analogous art test, the Jacklin reference clearly does not qualify as analogous art. In regard to the first step of the *Bott* test, an electronic picture frame is in a completely different field of art from computer systems and devices. These fields of art have absolutely no rational relationship. The former subject matter comprises a variety of photographic devices and processes, which are limited particularly to *displaying* images and sounds. In contrast, the latter subject matter relates to computers and processor-based computing systems. A skilled artisan in the field of photography and electronic picture frames would have little or no knowledge of computer-specific structures and configurations and vice versa. Therefore, the Jacklin reference is clearly not in the field of Applicant's endeavor.

In regard to the second step of the *Bott* test, the problems associated with photography and electronic picture frames are completely different from the problems associated with computers. Computers often require complex computing circuitry, processors, and other components to execute code, such as an operating system and

applications software. Moreover, given all of the components and peripherals of computers, the mounting problems are much more complex than electronic picture frames and space considerations are a major concern. Applicant addressed this space consumption problem in a unique and non-obvious manner by providing a upright or vertical mounting mechanism, while others have merely used horizontal mounts and deep horizontal mounting depths. *See* Goodrich et al., Figures 4, 9, and 17. In contrast, the problems associated with electronic picture frames arise primarily from the need for easy access and display of a large number of digitally stored pictures. *See* Jacklin, col. 1, lines 48-56. The problems associated with electronic picture frames do not concern the operation or problems associated with computers, nor do they have anything to do with mount structures for computers. Thus, there is no evidence whatsoever that similar problems exist in these disparate fields of art, much less any evidence to suggest that one of ordinary skill in the art of computers or computer mounts would consult the art of electronic picture frames or photography for any reason. Accordingly, the Jacklin reference is believed to be non-analogous art. Applicant respectfully requests removal of the Jacklin reference from consideration.

Second, the Examiner has not provided any motivation or suggestion to combine the references. In fact, one skilled in the art would not be compelled, or find it obvious, to combine the teachings of Goodrich et al. with those of Jacklin. As discussed above, photography and electronic picture frames are simply unrelated and non-analogous to computers and mounts for computers. Accordingly, claims 19 and 49 are believed to be patentably distinct from the cited references and in condition for allowance.

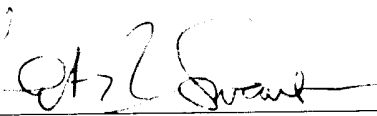
Accordingly, Applicant respectfully requests withdrawal of the outstanding §103 rejections and allowance of claims 19 and 49.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of claims 1-51. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the claims and to the specification by the current amendments. The attached page is captioned **"Version With Markings To Show Changes Made."**

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Tait R. Swanson
Registration No. 48,226
FLETCHER, YODER & VAN SOMEREN
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

1. (Amended) A space saving system for a computing device, comprising:
a housing for a display and a plurality of computing components; and
a mounting assembly for the housing configured to position the display in a desired upright orientation, the mounting assembly comprising a vertical mount structure configured to mount ~~that facilitates mounting of~~ the housing on a substantially vertical surface.

46. (Amended) A space saving method for a computing system, comprising:
integrating a display assembly with a plurality of computing components in a thin panel enclosure;
coupling a vertical support assembly to the thin panel enclosure; and
facilitating a shallow horizontal depth consumption of the thin panel enclosure via the vertical support assembly.